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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,108	08/10/2001	Lachlan Everett Hall	NPI003A-US	7453

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SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

COPPINS, JANET L

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/928,108

Applicant(s)

HALL ET AL.

Examiner

Janet L. Coppins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-6 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

5:02

DETAILED ACTION

Claims 1-6 pending in the instant application.

Election/Restrictions

1. The Markush group set forth in the claims includes both independent and distinct inventions, and patentably distinct compounds (or species) within each invention. However, this application discloses and claims a plurality of patentably distinct inventions far too numerous to list individually, regarding formula 1 of claim 1. Moreover, each of these inventions contains a plurality of patentably distinct compounds, also far too numerous to list individually. For these reasons provided below, restriction to one of the following inventions is required under 35 U.S.C. 121, wherein a Group is a set of patentably distinct inventions of a broad statutory category (e.g. compounds, compositions, methods of using, etc):

- I. Claims 1 and 4, drawn to compounds according to formula 1 of claim 1, classified in multiple subclasses of classes 540, 549, 556, 558, etc.
 - II. Claims 2 and 3, drawn to an infrared dye composition, classified in class .
 - III. Claims 5 and 6, drawn to a solvent-based ink composition, classified in class .
2. In addition to an election of one of Invention Sets I-III above, restriction is further required under 35 U.S.C. 121 as follows:

In accordance with the decisions in *In re Harnisch*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984), restriction of a Markush group is proper where the compounds within the group either (1) do not share a common utility, or (2) do not share a substantial structural feature disclosed as being essential to that utility. In the instant case, the compounds share only a tricyclic moiety in common

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(variables **excluded**), which does not constitute a substantial structural feature. In addition, a Markush group may encompass a plurality of independent and distinct inventions where two or more members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the other members obvious under 35 U.S.C. 103.

3. **Where an election of any one of Groups I-III is made**, an election of a single compound (or set of compounds) of formula 1 is further required, including an exact definition of each substituent on the base compound, wherein a single member at each substituent group or moiety is selected. For example, the base molecule has the substituent group X, wherein X is recited to be selected from the group consisting of CO, O, S, SO, SO₂, Se, SeO, SeO₂, etc ; therefore the applicant must select a single specific substituent for X, i.e. X= "S" in compound No. 8 on page 88 of the specification, and each subsequent variable position. In the instant case, upon election of a single compound, the Office will review the claims and disclosure to determine the scope of the independent invention encompassing the elected compound (compounds which are so similar thereto as to be within the same inventive concept and reduction to practice). The scope of an independent invention will encompass all compounds within the scope of the above-identified Group that the elected compound falls within (compounds which are so similar thereto as to be within the same inventive concept and reduction to practice). Examination will then proceed on the elected compound AND the entire scope of the invention encompassing the elected species, as defined by the above Groups and common classification. A clear statement of the examined invention, defined by those class(es) and subclass(es) will be set forth in the first action on the merits. Note that the restriction requirement will not be made final until such time as applicant is informed of the full scope of

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compounds along with (if appropriate) the process of using or making said compounds under examination. This will be set forth by reference to specific class(es) and subclass(es) examined. Should applicant traverse on the ground that the compounds are not patentable distinct, applicant should submit evidence now of record showing the compounds to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other.

4. All compounds falling outside the class(es) and subclass(es) of the selected compound and other compounds encompassed by the elected Group above will be directed to nonelected subject matter and will be withdrawn from consideration under 35 U.S.C. 121 and 37 C.F.R.

1.142(b). Applicant may reserve the right to file divisional applications on the remaining subject matter. (The provisions of 35 U.S.C. 121 apply with regard to double patenting covering divisional applications).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Markush claims must be provided with support in the disclosure for each member of the Markush group. See MPEP 608.01(p). Applicant should exercise caution in making a selection of a single member for each substituent group on the base molecule to be consistent with the written description.

Rationale Establishing Patentable Distinctiveness Within Each Group

6. Each Group listed above is directed to or involves compounds which are recognized in the art as being distinct from one another because of their diverse chemical structure, their different chemical properties, modes of action, different effects and reactive conditions (MPEP 806.04, MPEP 808.01). Additionally, the level of skill in the art is not such that one invention would be obvious over either of the other inventions (Groups), i.e. they are patentable over each other. Chemical structures that are similar are presumed to function similarly, whereas chemical that are not similar are not presumed to function similarly. The presumption even for similar chemical structures though is not irrefutable, but may be overcome by scientific reasoning or evidence showing that the structure of the prior art would not have been expected to function as the structure of the claimed invention. Note that in accordance with the holdings of Applications of Papesch, 50 CCPA 1084, 315 F.2d 381, 137 USPQ 43 (CCPA 1963) and In re Lulu, 223 USPQ 1257 (Fed. Cir, 1984), chemical structures are patentably distinct where the structures are either not structurally similar, or the prior art fails to suggest a function of a claimed compound would have been expected from a similar structure.

The above Groups represent general areas wherein the inventions are independent and distinct, each from the other because of the following reasons:

7. Invention I is distinct and independent from each of Inventions II and III. In this instance, the claims of Inventions II and III are different compositions. Insofar as the compounds of Invention I may be used in the practice of Inventions II and III, the compounds differ structurally, one from the other as defined by the different formulae, and absent factual

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evidence to the contrary, Inventions II and III are different chemical compositions that are intended for different utilities.

8. In addition, because of the plethora of classes and subclasses encompassed by the scope of the compounds claimed within each of the Groups, a serious burden is imposed on the Examiner to perform a complete search of the defined areas. Therefore, because of the reasons given above, the restriction set forth is proper and not to restrict would impose a serious burden in the examination of this application. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II-IV, etc., restriction for examination purposes as indicated is proper.

9. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement may be traversed (37 CFR 1.143).

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Coppins whose telephone number is 571.272.0680. The examiner can normally be reached on M-F 8:30-5:00.

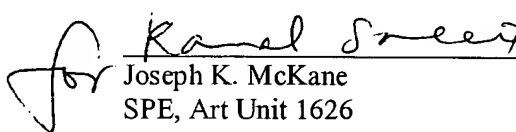
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571.272.0699. The fax phone number for the organization where this application or proceeding is assigned is 571.272.8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Janet L. Coppins
July 11, 2005

KAMAL A. SAEED, PH.D.
PRIMARY EXAMINER


Joseph K. McKane
SPE, Art Unit 1626